

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte XAVIER J. QUINONES,
JEFFREY B. SHERRY
and
JAMES R. HANSEN

Appeal No. 95-3870
Application 07/993,551¹

ON BRIEF

Before WILLIAM F. SMITH, ROBINSON, and LORIN, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

¹ Application for patent filed December 21, 1992. According to appellants, this application is a division of Application 07/898,373, filed June 9, 1992; which is a continuation of Application 07/564,928, filed August 8, 1990 (abandoned).

DECISION ON APPEAL²

This is an appeal under § 134 from the examiner's decision refusing to allow claims 1 through 41, all the claims in the application. Claims 1 and 40 are illustrative of the subject matter on appeal and read as follows:

1. A process for making small diameter skinless frankfurters comprising:

a) deshirring casing from a shirred stick of moisture and smoke permeable food casing adapted for use in stuffing and processing sausages, said casing comprising:

an elongated tube adjacent first and second longitudinal portions wherein at least one colorant or opacifier is dispersed in at least one of said portions of said tube to provide it with optical values which are different from the other portion, and wherein the second portion has a transverse width less than that for said first portion and said first and second portions have L, a, b, and opacity values as measured by colorimeter using the Hunter color scale meeting at least one of the following conditions:

i) an average opacity value of said first portion that is at least about 0.5% units greater than the average opacity value of said second portion;

ii) a difference in average opacity between said first portion and said second portion which is less than 10, and a difference between said first and second portion in their respective averages of either said L values or said a values or said b values of at least about 5; or

iii) a difference of at least about 10 or greater in average opacity between said first portion and said second portion, and the sum of the absolute values of a and b of the first portion following extraction of said casing with water and methanol is at least 10; and

wherein said tube has a tube wall thickness less than about 2.0 mils and a tube circumference less than 15 mm with said second longitudinal portion having an opacity of less than about 5.0% and a transverse width of at least about 3/16 inch;

² This application is a division of Application 07/898,373, Appeal No. 96-1992. We have considered the two appeals together.

- b) stuffing said shirred casing with sausage emulsion as the casing is deshirred;
- c) cooking and processing the encased sausage emulsion thereby causing a secondary skin to form on a cooked frankfurter;
- d) removing said casing from said cooked sausage with a high speed peeling machine; and
- e) repackaging said peeled sausage.

40. A process for monitoring color development in an encased sausage product comprising stuffing a casing with a meat emulsion to form an encased sausage, cooking said encased sausage, and monitoring color development of the encased sausage during cooking by viewing through said second longitudinal portion of said casing changes in color of the encased sausage surface wherein said casing comprises a cellulosic food casing comprising an elongated cellulosic thin walled tube having a moisture content of less than 100 wt. % based upon the weight of bone dry cellulose (BDC), said tube having first and second longitudinal portions, and a colorant or opacifier which is longitudinally and continuously dispersed in at least one of said portions throughout said tube wall to provide said portion with optical values which are different from said other portion, said portions having a surface area ratio of said first portion to said second portion of at least about 1:1 or greater, and wherein said first and second portions have L, a, b and opacity values as measured by colorimeter using the Hunter color scale which values meet at least one of the following conditions:

i) an average opacity value of said first portion that is at least about 0.5% units greater than the average opacity value of said second portion;

ii) a difference in average opacity between said first portion and said second portion which is less than 10, and a difference between said first and second portions in their respective averages of either said L values or said a values or said b values of at least about 5; or

iii) a difference of at least about 10 or greater in average opacity between said first portion and said second portion, and the sum of the absolute values of a and b of the first portion following extraction of said casing with water and methanol is at least 10.

The reference relied upon by the examiner is:

Grabauskas et al. (Grabauskas) (Canadian Patent)	603,307	Aug. 9, 1960
---	---------	--------------

In addition, the examiner relies upon so-called “admitted prior art” identified as appearing at page 1-9, 15 and 16 of the supporting specification. The examiner also relies upon statements made in a declaration filed under 37 CFR § 1.132 by co-appellant Jeffrey Sherry.

Claims 1 through 41 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Grabauskas, the so-called admitted prior art and the Sherry declaration. We reverse.

DISCUSSION

Claim 1 is directed to a process for making small diameter skinless frankfurters.³ For the purposes of deciding the issues raised in this appeal, we need only to consider that aspect of the claimed invention which involves the casing used in the claimed process. As set forth in claim 1 on appeal,⁴ the casing is to have adjacent first and second longitudinal portions. A colorant or opacifier is dispersed in at least one of the portions to provide that portion with optical values which differ from the other portion. The

³ The preamble of claim 1 indicates that the claim is directed to making frankfurters. However, steps d) and e) of claim 1 result in a formation and packaging of a “sausage.” Whatever difference in scope may exist between these two terms has not effected our ability to reach a decision on appeal. However, upon return of the application, we urge appellants and the examiner to review all the claims on appeal and ensure that the terms used within are consistent.

⁴ Claim 40 is the other independent claim on appeal and defines the casing in a similar manner.

second portion is to have a transverse width less than that of the first portion. As seen from claim 1 on appeal, the optical values for the two portions of the casings are to have specified values. The advantages of using a casing as specified in claim 1 are set forth in the paragraph bridging pages 11-12 of the supporting specification as follows:

The present invention seeks to provide a cellulosic casing and encased food product whereby the casing may advantageously have at least two longitudinal portions with different optical properties. In a most preferred embodiment of the invention a clear colorless, longitudinal portion is provided in an otherwise colored casing to allow either a manufacturer to view the encased product e.g. for color development during processing or a consumer to view the encased product e.g. for meat particle definition and quality. In this preferred embodiment the colored portion of the casing makes up an equal or greater surface area of casing relative to the clear portion in order to assist the manufacturer in quality control. This colored portion helps ensure that casing or casing segments are not mixed with meat emulsion for admission to the feed hopper of a stuffing machine e.g. by contamination of meat in the strip-out tub with casing. The colored portion of the casing also helps identify

unpeeled or partially unpeeled casing. Other embodiments of the invention provide casing having multicolored longitudinal portions or portions having different opacities to help differentiate one encased product from another and to provide attractive packaging for applications where the casing is left on until ultimate use by a consumer. Clear or relatively transparent colored or colorless portions may be provided to allow visual identification of product type and quality.

Appellants acknowledge in the paragraph bridging pages 8-9 of the supporting specification that prior to the present invention sausage processes have utilized strip casing. As explained on page 9 of the supporting specification, such casings typically were formed so that 50% of the surface area was clear, i.e., these casings had very narrow opaque strips. Certain problems were associated with using casings having narrow strips.

Grabauskas exemplifies such prior art casings. As set forth on page 4 of the examiner's answer, the examiner agrees that Grabauskas "differs in the transverse width of the opaque colored portion present on the casing." The examiner goes on to explain which it would have been obvious to one of ordinary skill in the art to increase the width of the opaque colored portion of the Grabauskas casing in order to arrive at the subject matter on appeal.

We need not spend any further resources considering the examiner's prima facie case of obviousness. In view of the examiner's treatment of appellants' evidence of nonobviousness, Mr. Sherry's declaration under 37 CFR § 1.132. Mr. Sherry's declaration

Appeal No. 95-3870
Application 07/993,551

was first presented in this application as an attachment to the appeal brief. As such, entry of the declaration was within the discretion of the examiner. 37 CFR

§ 1.195. As set forth on pages 1-2 of the examiner's answer, the examiner did enter the Sherry declaration, stating that he considered it.

As set forth in In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986):

If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Here, the examiner's consideration of the Sherry declaration consists of the following paragraph which appears at page 8 of the examiner's answer:

Appellants' argument of long felt need as evidenced by commercial success (brief, page 9, lines 5-6 & page 13, lines 4-11) has been considered. While striped casings have indeed been in use for over 30 years, the advent of colored casings in recent years suggests a new problem or consideration is addressed. Again, Sherry notes the positive effect of this recent development on detection problems; this declaration is considered an indication one skilled in the art would recognize increasing that the colored portion of a casing provides improved detection.

The Sherry declaration urges that casings used in the claimed process is the subject of commercial success. Mr. Sherry also urges that the casings required by the claims on appeal have been copied by others and that one of assignee's competitors have sought a license under any patents which may issue which cover the casing of the present

invention. Appendix D of the Sherry declaration is a letter to assignee from a customer stating that the casing used in the present process is a "significant improvement." The table at page 5 of the Sherry declaration sets forth sales figures of a casing such as that required by the claims on appeal as well as a striped casing which appears to be representative of that described by Grabauskas. In addition, the table sets forth sales data for a uniformly colored casing.

Manifestly, the examiner's consideration and treatment of the Sherry declaration is improper. The Sherry declaration presents objective data which is relevant in determining the obviousness of the claimed invention. As set forth in In re Hedges, supra, the examiner has not reweighed the entire merits of the matter. Rather, he has dismissed the evidence of nonobviousness in a cursory manner.

Again, the examiner did not have to admit the declaration when it was submitted with the appeal brief. However, the examiner did so. In admitting the declaration at that late stage in the proceedings, the examiner undertook the responsibility to fully and fairly evaluate that evidence. The examiner has not properly discharged that responsibility.

The filing and admission of the Sherry declaration shifted the burden of going forward to the examiner. As explained, the examiner did not properly discharge that burden. By statute, this Board serves as a Board of review, not a de novo examination tribunal. 35 U.S.C. § 7(b) (the [Board] shall, on written appeal of an applicant, review adverse decisions of examiner's upon application for patents ...). It is the examiner's

Appeal No. 95-3870
Application 07/993,551

responsibility to fully and fairly evaluate evidence of nonobviousness and notify appellants of any reasons why such evidence is insufficient. Appellants then would have an opportunity to respond and submit further evidence if needed. This did not occur here. Subsequently, the case forwarded to the Board by the examiner is not amendable to a meaningful review. What is needed is a fact-based explanation from the examiner explaining why the proffered evidence of nonobviousness is insufficient. Since the examiner did not do so on this record, the rejection cannot be sustained. The decision of the examiner is reversed.

REVERSED

WILLIAM F. SMITH)	
Administrative Patent Judge)	
)	
)	
)	
DOUGLAS W. ROBINSON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
HUBERT C. LORIN)	
Administrative Patent Judge)	

Viskase Corporation
Patent & Trademark Department
6855 West 65th Street

Appeal No. 95-3870
Application 07/993,551

Chicago, IL 60638

WFS/cam